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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,196	09/25/2000	Philip Carragher	Carr-P2-00	2986

28710 7590 11/27/2007  
PETER K. TRZYNA, ESQ.  
P O BOX 7131  
CHICAGO, IL 60680

EXAMINER
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KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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11/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/669,196

Applicant(s)

CARRAGHER ET AL.

Examiner

Stefano Karmis

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/3/07 9/4/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 14 September 2007.

### *Status of Claims*

2. Claims 1-56 are currently pending.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 7, 8, 11, 38, 39, 42, 43 and 45-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan U.S. Patent 6,386,444.

Regarding claim 1, 38, 42, 43, 55 and 56, Sullivan discloses a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount

to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner also notes that the crediting could simply be paying the insurance with the credit card); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Claim 2, applying some of the amount in a funds transfer to pay the expense (column 7, lines 51 thru column 8, line 3).

Claim 3 and 4, wherein the associating card activity with an external residential expense includes the entering external mortgage identifying data; and carryout out the crediting according to the data (column 7, lines 1-22).

Claim 7, 11, wherein the external residential expense is insurance (column 6, lines 38-59).

Regarding claim 8 and 39, Sullivan discloses a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and

generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Claim 45-54, obtaining identifying data for the external residential expense; and wherein the crediting is carried out with amount comprising a reward (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27, 36, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 6,386,444 in view of Petit U.S. Patent 4,722,554.

Claims 27, 36, 40 and 41, Sullivan teaches a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and

generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Sullivan fails to specify printing a check for the amount; printing a coupon with the amount for carrying out the payment of the mortgage with the check; and combining the check and the coupon with a statement of the card activity in an envelope so as to address the envelope to the cardholder. Pettit teaches an alternative value paper refund form in which a negotiable instrument, nominally a check, and one or more coupons. The form is typically used for a rebate or refund (column 3, lines 30-47 and column 9, lines 3-25). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Sullivan and include payment through postage because it is an efficient manner to transmit payment information stemming from a rebate or refund and is extremely well known in the financial and billing arts.

7. Claims 5, 6, 9, 10, 12-26, 28-35 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 6,386,444 in view of Official Notice.

Claims 5, 6, 9, 10, 37 and 44, Sullivan teaches wherein the external residential expense is insurance (column 6, lines 38-59). Sullivan fails to teach that the external residential expense is a closing cost or downpayment or an actual mortgage. Official Notice is taken that closing costs and downpayments and mortgages are old and well known as external residential expenses. Therefore it would have been obvious to one of ordinary skill in the art to modify the teachings of Sullivan to include closing costs or downpayments because they are external residential

expenses needing to be paid by the customer and the customer would thus have an incentive to use the card to provide payments for these expenses.

Regarding claims 12-26 and 28-35, Sullivan fails to teach the processing and applying of payment as discussed in these claims. Official Notice is taken that there are a plurality of ways to process and apply the payments. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Sullivan to include the processing and application of payments because it provides a system desirable to the customer so that a loyalty and financial relationship can better serve all parties with an interest in the financial transaction.

Claims 37, Sullivan teaches a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50). Sullivan fails to teach auctioning a proposed new mortgage. However, the limitation appears to be directed towards the intended use and is not a necessary component of the apparatus and thus is not interpreted to have patentable weight as part of the apparatus.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
Stefano Karmis  
26 November 2007

A handwritten signature in black ink, appearing to be 'Stefano Karmis', written over a horizontal line.